

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated October 1, 2007 ("Office Action"). At the time of the Office Action, Claims 1-8 and 10-16 were pending in the Application. In the Office Action, the Examiner rejects Claims 1-8 and 10-16. Applicant amends Claim 1. Applicant does not admit that any amendments are necessary due to any prior art or any of the Examiner's rejections. Applicant respectfully requests reconsideration, further examination, and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-8 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,555,334 issued to Ohnishi, et al. ("*Ohnishi*") and in view of U.S. Patent No. 5,787,215 issued to Kuhara, et al. ("*Kuhara*"). Applicant respectfully traverses these rejections. Applicant does not believe that any of the references cited by the Examiner fairly disclose, teach, or suggest Applicant's claimed invention. However, in order to clarify Applicant's invention, Applicant has amended Claim 1. Applicant respectfully requests allowance of all pending claims.

Amended Claim 1 recites, in part, "wherein...the receiving component is located away from the location where the diffraction structure concentrates the received light at the second wavelength." *Ohnishi* and *Kuhara*, alone or in combination, fail to disclose, teach, or suggest a number of elements of amended Claim 1. Instead, *Ohnishi* specifically teaches away from this element of amended Claim 1. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (M.P.E.P. § 2141.02). Moreover, although the Supreme Court recently denounced the rigid application of the "TSM" test in *KSR v. Teleflex*, 127 S.Ct. 1727 (2007), the Federal Circuit has subsequently found a patent not obvious where the relevant prior art taught away from the claimed invention. *Takeda Chemical v. Alphapharm*, 2007 WL 1839698 (Fed. Cir. 2007).

First, the Examiner states in the Office Action that "Ohnishi discloses that different wavelength[s] can be used in the device, and the receiving device has a surface or area extending over a sufficiently great length at least in the direction of displacement of the light spot." Office Action, p. 6. Therefore the receiving device in *Ohnishi* has a large surface area

so that light can be concentrated on it. As stated in the Office Action, “And when the position of the light receiving diode 7 is changed, disposition or orientation of the diffraction grating 6 must naturally be so adjusted that the diffracted light beam as selected can be **concentrated** onto the light receiving diode 7.” Office Action, p. 6 (emphasis added). Light receiving diode 7 in *Ohnishi* is specifically made large so that light can be concentrated on it. *Ohnishi* therefore fails to disclose, teach, or suggest “wherein...the receiving component is located away from the location where the diffraction structure concentrates the received light at the second wavelength.”

Additionally, the Examiner ignores the plain language and meaning of *Ohnishi*, as cited by Applicant in Applicant’s previous response. *Ohnishi* states “In this conjunction, it is however noted that when the position of the light receiving diode 7 is changed, disposition or orientation of the diffraction grating 6 **must** naturally be so adjusted that the diffracted light beam as selected can be **concentrated or focussed** onto the light receiving diode 7.” *Ohnishi*, Col. 8, lines 3-8 (emphasis added). *Ohnishi* therefore does teach, in some circumstances, locating a receiving device at the focus of the diffraction structure. *Ohnishi* also requires adjusting the diffraction grating 6 so that the diffracted light beam can be concentrated or focused on the light receiving diode 7. See *id.* This teaches away from amended Claim 1, which recites “wherein...the receiving component is located away from the location where the diffraction structure concentrates the received light at the second wavelength.” Because *Ohnishi* teaches away from this element, it cannot form the basis of a § 103 rejection.

Second, the Examiner claims that two receiving devices are used in Figure 7 of *Ohnishi*, and therefore “at least one of the receiving diode[s] is located away from the focus of the diffraction structure.” Office Action, p. 6. In Figure 7 of *Ohnishi*, “a pair of discrete light receiving devices 7a and 7b are disposed at positions where the plus-sign primary diffracted light beams 108a and 108b can impinge on these light receiving devices **separately from each other.**” *Ohnishi*, Col. 9, lines 49-54 (emphasis added). Light beams 108a and 108b are created as a result of diffraction of **two distinct received light beams**, 105a and 105b, which have different wavelengths. *Ohnishi*, Col. 9, lines 30-37. Therefore, the diffraction structure in Figure 7 concentrates light **at more than one location**. Receiving device 7a is intended to receive light beam 108a, so it is located where the diffraction structure concentrates light beam 108a. Similarly, receiving device 7b is intended to receive

light beam 108b, so it is located where the diffraction structure concentrates light beam 108b. Each receiving device has one received wavelength, and is located where that corresponding light beam is concentrated; the location of the concentration of the other light beam is not relevant. Accordingly, *Ohnishi* fails to disclose, teach, or suggest “wherein...the receiving component is located away from the location where the diffraction structure concentrates the received light at the second wavelength.”

Third, in response to Applicant’s previous arguments, the Examiner created Figures O1 and O2 and discussed them in the Office Action. Office Action, p. 3-4. These figures are not found in *Ohnishi* or any other reference cited by the Examiner. The Examiner uses these figures to show that “it is not necessary for the receiving diode to be placed at the focus of the diffraction structure.” However, the Examiner fails to provide any evidence, other than Examiner’s own figures and discussion, or cite any prior art reference for this assertion. Examiner’s figures do not qualify as prior art under any patent statute. Additionally, as described below, Examiner’s figures are not representative of any reference cited by the Examiner.

The Examiner appears to use figures O1 and O2 as a substitute for the teachings of *Ohnishi*. Office Action, p. 4. However, although Examiner’s figures show two receiving devices, the two receiving devices are structured and utilized differently than the two receiving devices in Figure 7 of *Ohnishi*. The Examiner use of these constructed figures misrepresents the discussion in *Ohnishi*. Office Action, p. 3-4. *Ohnishi* uses two receiving devices when utilizing **more than one received light beam**, as described above. *Ohnishi*, Col. 9, lines 30-54. The Examiner’s constructed figures only show one received light beam, in contrast to *Ohnishi*, and thus are irrelevant for the purposes of describing what *Ohnishi* discloses.

Kuhara fails to cure the deficiencies of *Ohnishi*. *Kuhara* describes a photodiode/laser diode module with a light receiving surface with a diameter from 100 μm to 200 μm . As *Kuhara* states, “A receiving surface of wider than a 100 μm diameter can catch almost all the light emitted out of the fiber (62).” *Kuhara*, Col. 21, lines 35-39. In other words, *Kuhara* attempts to locate a receiving component near or at the location where received light is concentrated, so as to catch almost all of the emitted light. Therefore *Kuhara*, alone or in combination, fails to disclose, teach, or suggest “wherein...the receiving component is

located away from the location where the diffraction structure concentrates the received light at the second wavelength.”

The Examiner rejects Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Kuhara* as applied to claims 1 and 7 above, and in further view of U.S. Patent No. 6,504,975 issued to Yamagata, et al. (“*Yamagata*”).

The Examiner rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Kuhara* as applied to claims 1 and 7 above, and in further view of U.S. Patent No. 5,600,486 issued to Gal, et al. (“*Gal*”).

The Examiner rejects Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Kuhara* as applied to claim 1 above, and in further view of Japanese Kokai Patent Application No. Hei 9[1997]-325246 to Saito (“*Saito*”).

The Examiner rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Kuhara* and *Saito* as applied to claims 1 and 14 above, and in further view of U.S. Patent Application Publication No. 2003/0007753 A1 to Hurt, et al. (“*Hurt*”).

The Examiner rejects Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Kuhara* and *Saito* as applied to claims 1 and 14 above, and in further view of U.S. Patent No. 5,537,504 issued to Cina, et al. (“*Cina*”).

Claims 2-8 and 10-16 depend from Claim 1, shown above to be allowable. For at least these reasons, Applicant respectfully requests reconsideration and allowance of all pending Claims.

CONCLUSION

For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicant, at the Examiner's convenience at (214) 953-6581.

Applicant is filing concurrently herewith a Request for Continued Examination Transmittal and a one-month Notice of Extension of Time. No other fee is believed due; however, the Commissioner is hereby authorized to charge any additional fee or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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